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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/463,681	01/31/00	BLUM	J PM266043

000909  
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IM52/1109

EXAMINER

MAYEKAR, K

ART UNIT PAPER NUMBER

1741

*16*

DATE MAILED: 11/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.

09/463,681

Applicant(s)

J. Blum et al.

Examiner

Kishor Mayekar

Art Unit

1741



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 22, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

Art Unit: 1741

## DETAILED ACTION

### *Continued Prosecution Application*

1. The request filed on 10/22/01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/463,681 is acceptable and a CPA has been established. An action on the CPA follows.

### *Claim Objections*

2. Claim 1 is objected to because of the phrase "characterized in that". It is preferred to replace with the above phrase with the phrase --comprising-- to conform with the standard U.S. practice and to change the recited steps to an active voice, e.g. applying, stoving, shaping, electrophoretically depositing, stoving and applying. Appropriate correction is required.

Art Unit: 1741

*Claim Rejections - 35 USC § 112*

3. Claims 1, 4, 7 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "whereupon a substrate not yet in the desired three-dimensional shape is shaped" is confusing as whether it is the same electrically conductive substrate or different and if the same whether the shaping is done after the application of the primer layer or else. The phrase "a third coating layer of the protective and decorative laminar structure" is confusing as whether the laminar structure of the three-dimensional substrate and that of the electrically conductive substrate is the same or different.

Regarding claim 4, the phrase "optionally previously" is confusing as to the meaning of "previously".

Regarding claim 7, the recitation of the phrase "stoved" is confusing as whether it is an extra stoving step or else.

Art Unit: 1741

Regarding claim 10, the claim is indefinite because of the missing phrase "the process of" before the phrase "claim 1".

*Claim Rejections - 35 USC § 103*

4. Claims 1-6 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 02300281A in view of MATSUO et al. (5,190,830). The reference's invention is directed to a method for temporary protection of coated surface of new cars for transportation which comprises the step of applying removable pressure sensitive adhesive plastic film and/or wrapping with heat shrinkable plastic film (see the abstract). The difference between the reference and the above claims is the recitation of the first two steps. MATSUO, a reference cited the last Office action, shows the recited first two steps for coating cars (col. 2, lines 21-32; col. 3, line 65 through col. 4, line 13; col. 4, lines 42-52; and Examples). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the reference's teachings as shown by MATSUO

Art Unit: 1741

because the selection of any of known car's coating process prior to the step of applying and/or wrapping with plastic film would have been within the level of ordinary skill in the art.

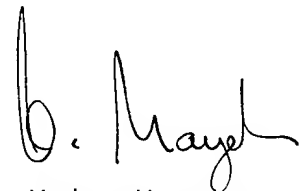
5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '081 in view SOLTWEDEL et al. (5,624,978). The difference between the reference as applied above and the above claims is the recitation of the first two steps. SOLTWEDEL shows the recited first two steps for coating cars (see abstract; col. 2, lines 41-59; and col. 11, lines 11-38). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the reference's teachings as shown by SOLTWEDEL because the selection of any of known car's coating process prior to the step of applying and/or wrapping with plastic film would have been within the level of ordinary skill in the art.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (703) 308-0477. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:00 PM.

Art Unit: 1741

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathryn Gorgos, can be reached on (703) 308-3328. The fax phone number for this Group is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'K. Mayekar', with a stylized, cursive script.

Kishor Mayekar  
Primary Examiner  
Group 1700

KM  
November 8, 2001